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Andreas Fink

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26646

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EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

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07/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/524,811 | <b>Applicant(s)</b><br>FINK ET AL. |  |
|                              | <b>Examiner</b><br>David C. Reese    | <b>Art Unit</b><br>3677            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11, 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/16/2008 has been entered. Consequently, the following is the current listing of claims in the instant application:

### ***Status of Claims***

- Claims 1-8, 12, and 18 were canceled.
- Claims 9 and 14 were amended.
- Claims 9-11, 13-17 are pending.

### ***Drawings***

[1] The drawing(s) were previously objected for informalities. In view of Applicant's amendment to the claims submitted on 4/16/2008, all previous objection(s) to the drawings have been withdrawn.

### ***Specification***

[2] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 4/16/2008. Accordingly, the objection(s) to the specification have been withdrawn.

### ***Claim Objections***

[3] Claim 9 recites the limitation "the axis" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 112***

[4] Applicant has to some degree addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 4/16/2008. Accordingly, the Examiner has not withdrawn all the 35 USC § 112 rejections. More specifically:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-11 and 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites “wherein a surface of the head that is perpendicular to the axis of the shank and not attached to the shank is smooth”. It is unclear to the examiner how if the head [disclosed by applicant as 2] is connected to the shank, how a surface of the head cannot be connected to the shank as well. Any surface of a head {of which is connected to a shaft} is therefore considered connected to the shaft as well. Claims 10-11 and 13-17 are dependent upon claim 9. In resolving said issue, the applicant may want to consider further limiting the structure of the head, i.e., the head has a top surface, bottom surface, said bottom surface connecting said head to said shank, with said top surface having a smooth and round surface, for example.

#### ***Claim Rejections - 35 USC § 102***

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[6] Claims 9-11, 13-14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacob et al USP 6309132 because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Jakob discloses of a fastening comprising:

a first component with a threaded bushing (housing 10 with threaded inserts 16,18, Column 2 lines 52-65)

a 2<sup>nd</sup> component (column 40) with a keyhole-like cut out with a smaller 50,52 and larger opening 46,48 (42,44, see Column 2 line 64-Column 3 line 6)

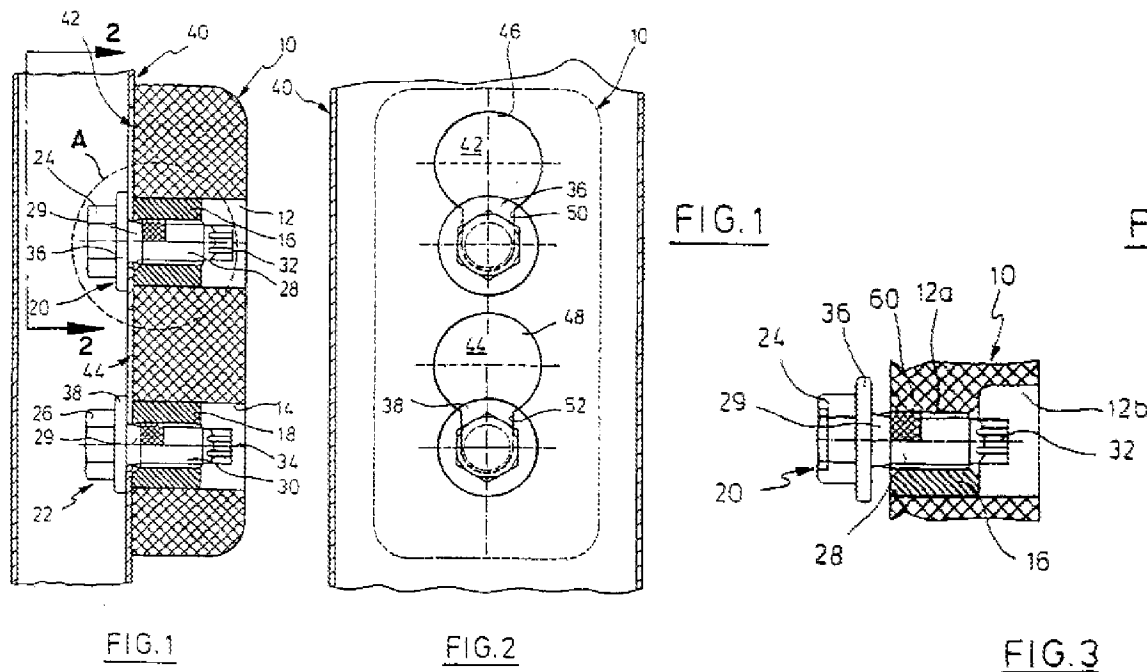
a self-locking (Column 3 lines 18-23, copied below) bolt (20) configured to be screwed into bushing such that it is guided with the head (24,36 is considered the head) through the larger opening (Fig 2) and head (24, 36) engages behind the smaller cut out, said bolt having tool engagement surfaces (32) at an end of the shank (28), wherein the head is round wherein a surface of the head that is perpendicular to the axis of the shank (the top of 38 is perpendicular to an axis of the shank and is round and smooth) and not attached to the shank is smooth.

Re claim 10: engagement surfaces are TORX® which is an external teething.

Re claim 11: Left hand thread is taught in Column 3 line 24-25.

Re claim 13: Self-locking bolt is taught in Column 3 lines 17-23 as a coated thread (60).

shank is partially provided with a plastic coating 60 which allows the fastener 20 to remain in the pre-assembled position. The coating 60 not only secures the pre-assembled state, but also locks the screw when finally tightened as shown in FIG. 1.



Re claim 14: It has been held that all threads are to some extent thread-forming for a corresponding bore, and thus would be for a corresponding bushing. As noted above, the thread and its coating are self-locking.

Re claim 17: The fasteners are described as threaded shanks in Column 2:

Threaded fasteners 20, 22 are provided with a head 24, 26, threaded shanks 28, 30 and ends 32, 34. The threaded shank 28, 30 are threaded into the inner threads of the inserts 16, 18. The ends 32, 34 of the shanks 28, 30 each have a Torx-portion. The heads 24, 26 have integrally formed radial flanges 36, 38. A non-threaded portion 29 joins the heads 24, 26.

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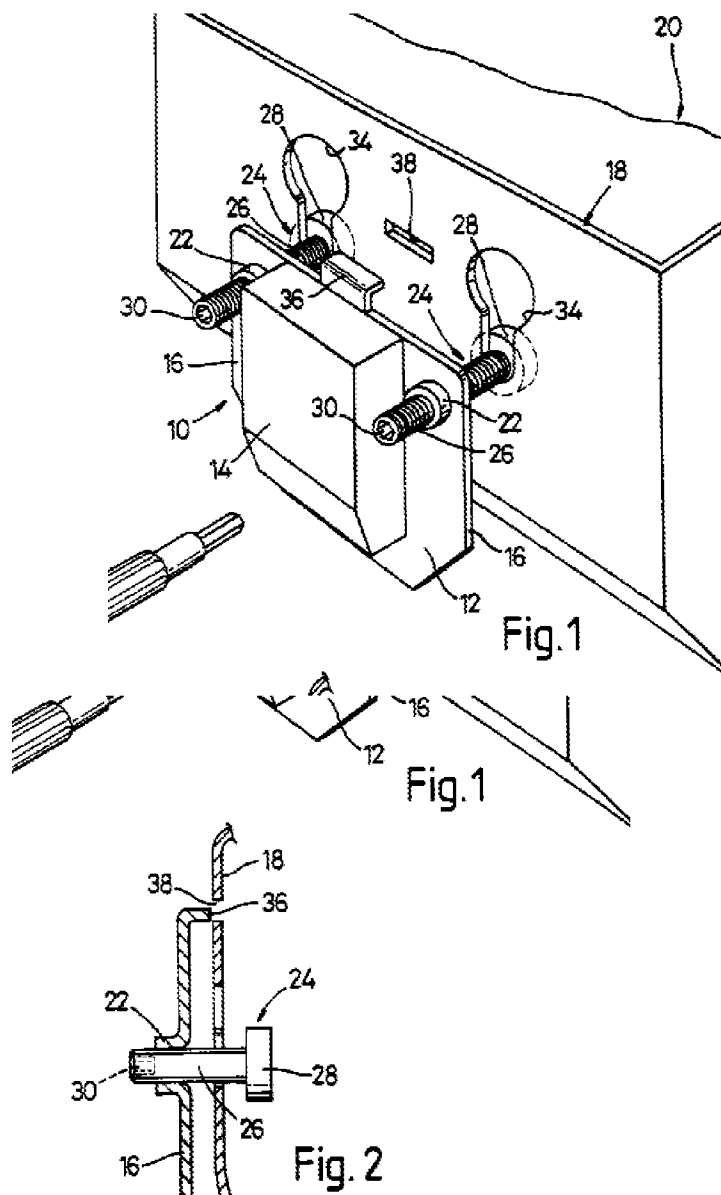
[7] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[8] Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakob et al USP 6309132 in view of EP 0747604. As noted above, examiner was unable to obtain a copy of the document, but she did obtain a copy of the figures, and thus is applying the reference as best she can, rather than give no opinion until the entire document is submitted.

EP 604 teaches a similar fastener to that of Jakob, but includes mating parts 36,38 which serve to prevent both rotation and translation of the 1<sup>st</sup> component when assembled. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Jakob and EP 604 before him at the time the invention was made, to modify Jakob as taught by EP604 to include translational and rotational guards to prevent translation of the 1<sup>st</sup> component and rotation of the 1st component in order to obtain a secure and stable assembly. One would have been motivated to make such a combination because if the components were allowed translational and/or rotational movement, the heads could move to the larger hole of the keyhole and the assembly would come loose.

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### *Response to Arguments*

[9] Applicant's arguments and remarks filed 4/16/2008 regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. Applicant's arguments concerning the amendment of "wherein a surface of the head that is perpendicular to the axis of the shank and not attach to the shank is smooth" is considered moot to that articulated by the examiner



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above in both the 112 and 102 rejections above. Though the examiner would like to point out that element (24, 36) of Jakob et al. meets every structural limitation of the claimed head. The fact that Jakob et al. may use different terminology to describe this member does not preclude it from reading on the claimed head. As stated above in the 112 rejection, the applicant may want to consider adding further limitations to the considerably broad head structure presented in the instant claim to help properly differentiate the head of the instant invention from that of the prior art of Jakob et al. Applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974), and that things clearly shown in reference patent drawings qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

### ***Conclusion***

**[10] THIS ACTION IS NON-FINAL**

**[11]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./

Examiner, Art Unit 3677

/Robert J. Sandy/

Primary Examiner, Art Unit 3677